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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,874	11/17/2000	Carl M. Sullivan	30222/20:100	7638
23446	7590	10/31/2006	EXAMINER	
MCANDREWS HELD & MALLOY, LTD			FERGUSON, LAWRENCE D	
500 WEST MADISON STREET			ART UNIT	PAPER NUMBER
SUITE 3400				
CHICAGO, IL 60661			1774	

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/715,874	SULLIVAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lawrence D. Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 August 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4,5,8-11,18,19,21-23,25-29,31 and 32 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4,5,8-11,18,19,21-23,25-29,31 and 32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

***DETAILED ACTION***

***Response to Amendment***

1. This action is in response to the amendment mailed August 21, 2006.

Claims 1 and 18 were amended, claims 31-33 were added and claim 30 was cancelled rendering claims 1-2, 4-5, 8-11, 18-19, 21-23 and 25-30 pending. Examiner regrets the withdrawal of the indicated allowability of claims 22-23, 25-26 and 29-30 and further prosecutes the claims.

***Claim Rejections – 35 USC § 102(b)***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4-5, 8-11, 22-23, 25-26, 29 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenlee (U.S. 5,248,546).

Greenlee discloses a multilayered article comprising a first layer of polyvinyl chloride and a second layer of polyvinyl chloride, which are adjacent to each other (column 2, lines 17-45) where the PVC compounds contain plasticizers (column 5, lines 8-14). Greenlee discloses the PVC containing layers comprise antistatic agents having levels less than 20phr (column 6, lines 44-55) which is a surface reactive agent. The

reference discloses the epoxidized soybean oil plasticizer (second plasticizer) ranges from 0.5 to 10 phr (column 5, lines 56-65) and a polyester plasticizer such as adipates, where at least one optional plasticizer may be included in any layer (column 5, lines 66-67, column 6, lines 27-28 and column 15, lines 1-5). Greenlee discloses along with the addition of plasticizers, copolymers can be incorporated in the layers as well (column 6, lines 20-26) such as polyester adipates (column 14, line 56 through column 15, line 5). The reference discloses the second layer is at least three degrees Celsius higher than the heat distortion temperature (melting point) of the first layer (column 2, lines 36-40). In claim 22, the phrase, "degree of stiffness suitable for wrapping foods and an oxygen transmission rate suitable for wrapping foods" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

Because Greenlee teaches an article comprising two layers of polyvinyl chloride and epoxidized soya bean oil plasticizer, where the two layers have different melting points, it is inherent for one of the layers to seal to itself when heat is transferred through the other layer, for the two layer to have different gas permeabilities and for the film to be visually clear. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art.

***Claim Rejections – 35 USC § 103(a)***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greenlee (U.S. 5,248,546).

Claim 1 is relied upon as above. Greenlee does not explicitly disclose the thickness of the film. Although Greenlee does not specifically disclose the thickness of the film, thickness is an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the film because discovering an optimum or workable range involves only routine skill in the art. The thickness directly affects durability and flexibility of the film. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215.

***Claim Rejections – 35 USC § 103(a)***

6. Claims 18-19, 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon et al (U.S. 3,650,775).

Simon discloses a packaging film (column 1, lines 4-5) which is clearly transparent (column 2, lines 15-17) having top and bottom polyvinyl chloride copolymer plies, which are non-fogging and have slip additives (surface active agent) (column 3, lines 3-15). The packaging film comprises polyvinyl chloride films having plasticizers

such as di(2 ethyl hexyl) adipate and epoxidized soya bean oil (column 4, lines 4-9). In claim 18, the phrase, "degree of stiffness suitable for wrapping foods and an oxygen transmission rate suitable for wrapping foods" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Simon does not explicitly disclose the thickness of the film. Although Simon does not specifically disclose the thickness of the film, thickness is an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the film because discovering an optimum or workable range involves only routine skill in the art. The thickness directly affects durability and flexibility of the film. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215.

### ***Response to Arguments***

7. Applicant's arguments to rejection made under 35 U.S.C. 102(b) as being anticipated by Greenlee (U.S. 5,248,546) has been considered but is unpersuasive. Applicant agreed with the prior office action, which stated Greenlee does not teach or suggest the recited packaging film including the limitation of one of the two layers melting and sealing itself when heat is transferred through the other layer. Upon further consideration, because Greenlee teaches an article comprising two layers of polyvinyl chloride and epoxidized soya bean oil plasticizer, where the two layers have different melting points, it is inherent for one of the layers to seal to itself when heat is transferred

through the other layer, for the two layer to have different gas permeabilities and for the film to be visually clear. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1774

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson  
Patent Examiner  
AU 1774



RENA DYE  
SUPERVISORY PATENT EXAMINER

Art Unit 1774  
1/27/02